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10/045,586	01/11/2002	Fred C. Mitchell	3524/22	8535

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EXAMINER

CORRIELUS, JEAN M

ART UNIT PAPER NUMBER

2162

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/045,586

Applicant(s)

MITCHELL ET AL.

Examiner

Jean M. Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,4-14,16-40 and 46-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4-14,16-40 and 46-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the amendment filed July 20, 2006, in which claims 2, 4-14, 16-40 and 46-54 are presented for further examination.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 2, 4-14, 16-40 and 46-54 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

### ***Claim Objections***

3. Claim 13 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 14. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 2, 4-14, 16-40 and 46-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically, as directed to an abstract idea. Claims 2, 4-14, 16-40 and 46-54 in view of MPEP section 2106 IV.B.2. (b) define non-statutory processes because they merely manipulate an abstract idea. More specifically, claims 2, 4, 29, 30, 31, 36, 46, 47, 50 and 51 recite a body law with a plurality of topics, wherein said body law is associated with a temporal information, which indicated the legal applicability. Such

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limitations of the claims are just an abstract idea without product a concrete result. There is no manipulation of data nor there is any transformation of data from one state to another being performed. Although there is post computer process activity, however, there is no physical transformation or a concrete and useful result being found in the claims. Therefore, claims 2, 4-14, 16-39 and 46-54 are directed to an abstract idea that is not tied to a technological art, environment or machine which would produce a concrete and useful result to form the basis of statutory subject matter under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 112***

6. Claims 2, 4-14, 16-40 and 46-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recite line 3 "its". Pronouns are not permitted, only what is being referred by "this" and "its" should be set forth in the claim. Applicants are advised to amend the claim so solve the 112 rejection set forth in the claim.

7. Claims 2, 4, 29, 30, 31 and 36 recites the limitation "the encoded information collection" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 2, 4-14, 16-29, 46, 47 and 49-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Timothy et al., (hereinafter "Timothy") article entitled "Databases of legislation: the problems of consolidations".

As to claim 2, Timothy discloses the claimed "a body of law" (legislative) "comprises one or more parts"(single act of parliament might be broken down into may hundreds of numbered sections, which in turn are broken in to numbered sub-sections or paragraphs and sub-paragraphs (page 2, section 1.1); and "temporal information stored in association with respective parts of the body of law and comprising one or more dates indicating the legal applicability of the respective part of the body of law" (page 2, paragraph 1.2); and "the body of law comprising a plurality of topics each having associated therewith at least one part of the body of law at least one of the topics having associated therewith a plurality of parts of the body of law that are different versions of each other and have different temporal information associated therewith" (page 2, paragraphs 1.11 and 1.2).

As to claim 4, Timothy discloses the claimed "a body of law" (legislative) "comprises one or more parts"(single act of parliament might be broken down into may hundreds of numbered sections, which in turn are broken in to numbered sub-sections or paragraphs and sub-paragraphs (page 2, section 1.1); and "a plurality of topical units, each comprising at least one topic within a scheme for organizing a plurality of interrelated topics, being stored in association with at least one information unit, and including information related to the at least one information unit associated therewith" (page 2, section 1.2); "each information being stored in association with temporal information comprising one or more dates indicating the legal applicability of the at

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least one part of the body of law including respective information unit, and at least one topical unit having associated therewith a plurality of information units that each include different versions of the same part of the body of the law and have different temporal information associated therewith” (page 2, paragraph 1.1 and 1.2).

As to claims 5 and 6, Timothy discloses the claimed “wherein the information collection is structured so that a part of the body of law can be accessed based on at least on the temporal information associated therewith” (section 1.2)

As to claim 7, Timothy discloses the claimed “wherein the information collection is structured so that an information unit can be accessed based on at least on the temporal information associated therewith, directly or through a topical unit with which that information unit is associated” (section 2)

As to claim 8, Timothy discloses the claimed “wherein each information unit includes the associated temporal information” (section 1.2)

As to claim 9, Timothy discloses the claimed “wherein at least one link exists each information unit and the temporal information associated therewith” (structural element at the higher level tree (page 8, paragraph 2).

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As to claim 10, Timothy discloses the claimed “wherein the information unit comprises structured document including a part of the body of law and the temporal information associated therewith” (section 1.2)

As to claim 11, Timothy discloses the claimed “wherein the representation of the information collection comprises a relation database including record, and each information unit and the temporal information associated therewith are included in a respective record” (section 4).

As to claim 12, Timothy discloses the claimed “wherein the representation of the information collection comprises a plurality of files each file storing at least one information unit and its associated temporal information (section 2).

As to claims 13 and 14, Timothy discloses the claimed “wherein the representation of the information collection comprises a plurality of files, each file storing at least one topical unit, each information unit associated therewith, and the respective temporal information associated with each information unit associated therewith” (section 2)

As to claim 16, Timothy discloses the claimed “wherein the information collection comprises a hierarchical arrangement of topical units and associated information units” (page 3, section 2)

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As to claim 17, Timothy discloses the claimed “wherein the information associated with a topical unit includes the temporal information stored associated with at least one of the information units associated with the respective topical unit” (section 7.3)

As to claim 18, Timothy discloses the claimed “wherein the information collection is hierarchically organized as a topic tree that comprises a plurality of nodes, with each node representing one of the topical units, the tree having leaf nodes representing atomic topical units, each information associated with a respective topical unit is associated with the leaf node representing that topical unit” (page 12, section 7.1).

As to claim 19, Timothy discloses the claimed “wherein the information collection comprises at least one table of contents (TOC) associated with the respective atomic topical unit” (page 1)

As to claim 20, Timothy discloses the claimed “wherein the temporal information includes a date range”(pages 3-5)

As to claim 21, Timothy discloses the claimed “wherein the temporal information includes a date range, and wherein the information collection is structured so that of the body of law can be accessed based at least on a date encompassed by the date range associated with that part of the body of law” (page 1)



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As to claim 22, Timothy discloses the claimed wherein the temporal information includes a date range, and wherein the information collection is structured so that an information unit can be accessed based at least on a date encompassed by the date range associated with that information unit" (page 2-3).

As to claim 23, Timothy discloses the claimed "wherein the temporal information comprises a date range including a date on which the related part of the body of the law is effective, and if that part of the law has a date of termination the date termination" (pages 2-3)

As to claim 24, Timothy discloses the claimed "wherein at least one part of the body of law has associated therewith a date on which that part of body of law included was adopted" (page 2, section 1.2).

As to claim 25, Timothy discloses the claimed "wherein at least one information unit has associated therewith a date on which the part of body of law included in the information unit was adopted" (section 1.2)

As to claims 26 and 27, Timothy discloses the claimed "wherein the body of law includes at least one title of the United State Code of Federal Regulation" (page 2, section 1.2).

As to claim 28, Timothy discloses the claimed "wherein the body of law includes at least one title of a codified set of laws of at least one state" (page 2, section 1.2).

As to claim 29, all the limitations of claim 29 have been mentioned in the rejection of claim 4-14 and 16-28. In addition, Timothy discloses the claimed “wherein a plurality of the atomic parts of the body of law comprises different versions of the same atomic part of the law, each having different temporal information associated therewith, and each atomic part and the temporal information associated therewith are included together in the same structured document” (section 6.2, and pages 11-12, section 7.1).

As to claims 50-52, Timothy discloses the claimed “displaying on a computer display device coupled to the computer dates in association with information identifying at least two part that are different versions of each other” (page 2, section 1.1 and 1.2); “displaying on the computer input device coupled to the computer” (page 2, section 1.1 and 1.2); “inputting to the computer using device the identify of a part of the body of law and a date; and in response thereto, the computer causing the computer display device to display that part whose identify was input to the computer and which has temporal information encompassing the inputted date” (page 2, section 1.1 and 1.2).

As to claim 53, Timothy discloses a collection of information organizing into topical units at least one of which includes the plurality of information units having different versions” (page 14, section. 6.2; and page 12).

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As to claims 46, 47 and 49, Timothy discloses “a computer system including a computer display device, a computer input device, computer readable medium” (page 2, section 1.1 and 1.2); “the medium storing uniquely identifiable part of a body of law in association with the temporal information (section 1.2 and 2); and “the computer system being programmed to display on the computer display device, in response to input from the computer input device, the identify of at least two parts of the body of law that are different version of each other together” (page 9, section 6.1, page 12 and page 14, section 6.2).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 30-40, 48 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timothy et al., (hereinafter “Timothy”) article entitled “Databases of legislation: the problems of consolidations” and Wiltshire et al., (hereinafter “Wiltshire”) WO 01/11559.

As to claims 30, 31 and 54, Wiltshire discloses a plurality of lower level structure documents defining a body of law, which includes a plurality of atomic parts (page 7, lines 19-23; page 8, lines 18-23); “at least one higher level structured document, including information relating to at least one lower level structured document (page 8, lines 18-23); and at least one higher level structured document has information relating to the plurality of lower level structured document (page 8, lines 18-23; page 10, lines 18-27). However, Wiltshire does not explicitly disclose the use of wherein a plurality of the atomic parts of the body of law comprises different versions of

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the same atomic part of the body of law, each having different temporal information associated therewith". On the other hand, Timothy discloses the use of a plurality of the atomic parts of the body of law comprises different versions of the same atomic part of the body of law, each having different temporal information associated therewith (page 9, section 6.1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the legal concept extraction system as disclosed by Wiltshire would incorporate the use of a plurality of the atomic parts of the body of law comprises different versions of the same atomic part of the body of law, in the same conventional manner as disclosed by Timothy (page 9, section 6.1). One having ordinary skill in the art would have found it motivated to use such a different versions of a body of law in the legal system of Wiltshire for the purpose of allowing a single authoritative store of the original document of the Act to be stored in the system, thereby dynamic links can be maintained across different versions.

As to claim 32-40 and 48, Wiltshire and Timothy disclose substantially the invention as claimed. In addition Wiltshire discloses a table content, wherein the table content having a reference to at least one other higher level structured document, and wherein the table of content having a plurality of heading each identifies one or more atomic parts of the body of law<sup>1</sup>, Timothy discloses the claimed (page 7, lines 19-23; page8, lines 18-23; page 10, lines 20-27; page 15, lines 18-25; page22, lines 3-23; page 23, lines 16-23; and page 24).

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

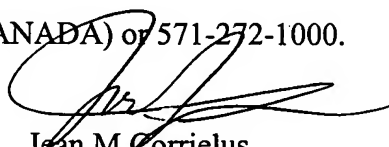
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jean M Corrielus  
Primary Examiner  
Art Unit 2162

October 16, 2006